

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Art Unit : 3714
Examiner : David W. Duffy
Applicant : Orlando W. Stephenson III
Appln. No. : 10/810,911
Filing Date : March 26, 2004
Confirmation No. : 9439
For : GAMING MACHINE

REPLY BRIEF UNDER 37 C.F.R. §1.193

This brief is in reply to the Examiner's answer mailed June 23, 2008. This brief is presented to address issues in the arguments raised by the Examiner in the Answer.

The Examiner has in large part repeated the rejection of claims 1-25 as being unpatentable over Cole U.S. Pat. No. 6,475,087 in view of Englman U.S. Publication No. 2003/0157978, but the Answer further makes some additional statements that purportedly support his arguments.

Specifically, the Answer continues to try and minimize a significance of the present defined structure which provides an adjustable cross bar. In the Examiner's Answer, page 7, under paragraph "(10) Response to Argument," line 7 of that paragraph, the answer states "In order to adjust this cross member, it is unbolted from the plate, new holes are drilled or may have been pre-drilled and the cross bar is then bolted in the new position using the new holes." The Examiner's Answer then states, "While this is technically vertically adjustable, it is not adjustable in the sense that a person of the gaming machine would be able to do so easily or without tools and access to the interior of the game machine." Applicant disagrees with the assertion "technically . . . adjustable." Applicant asserts that the present concept is adjustable, period. The Examiner further then states that the cross bar is "removably affixed to the game cabinet rather than adjustable in the literal meaning." The Answer does not cite any resource to explain

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where he got this “literal meaning” of the word “adjustable.” The Answer then goes on to focus on the concept of a removable cross bar and why it is obvious over the prior art. Applicant points out that this is an improper argument for at least two reasons. First, “adjustable” means “adjustable.” Further, the word “adjustable” clearly has a different meaning than “removable.” For example, the word “adjustable” includes both something that is infinitely adjustable, and also something that is adjustable to a plurality of discrete positions. Contrastingly, the word “removable” does not include either one. Second, the word “adjustable” defines the ability to position a cross bar in different height positions as recited in the claim. Neither Cole nor Englman teach or suggest any such adjustability.

The Answer on pages 8+ further attempts to minimize the significance of adjustability, taking the position that Englman teaches a cross member that could possibly be removable. The Examiner admits that the showing is not clear. But regardless of this deficiency, the Examiner then takes the position that Cole teaches a gaming machine with a replaceable display mount that allows “rapid changing of a game machine between electronic displays and real system to facilitate game changes and hardware updates” (page 8, line 9) . . . and then attempts to combine these two references to arrive at a combination teaching the present gaming cabinet. As noted previously, neither Cole nor Englman teach an adjustable cross member. Further, there is a lack of motivation or suggestion in either Cole or Englman to combine the references, and even if combined, they still do not teach an adjustable cross bar. Instead, if Cole and Englman are combined, a first panel is removed and thrown away, and a second panel is attached (with a cross bar in a different position).

The Examiner concludes in the last couple lines on page 11 that “in response to Applicant’s arguments that the Examiner’s conclusion of obviousness is based on improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

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hindsight reasoning.” The Examiner further continues on page 12 “But so long as it [hindsight reasoning] takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gained only from the Applicant’s disclosure, such a reconstruction is proper.” While it is true that the level of skill in an art area should be considered, the Examiner has based his entire argument on the fact that a skilled artisan would simply know to make a cross bar adjustable . . . without fully considering the Expert’s Declaration that states this is not the case. The cited art is totally void of any showing or suggestion of adjustability. Further, there is no suggestion or teaching of any structure which would allow repositioning of a cross member at different height positions. Accordingly, Applicant strongly urges that this rejection of claims is clearly based on improper hindsight reasoning and the Examiner has not adequately made a *prima facie* case of obviousness.

For the above reasons, Applicant traverses the rejection of Examiner, and the Board is requested to reverse the rejection on all counts and cause allowance of pending claims.

If there is any fee due in connection with the filing of this Reply Brief, please charge the fee to our Deposit Account No. 16-2463.

Respectfully submitted,

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Date

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